IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	David Aaron Crowther et al.
Serial No.:	10/519,856
Filing Date:	December 29, 2004
Examiner:	Sherief Badawi
Group Art Unit:	2167
Attorney Docket No.:	PU020329
Confirmation No.:	9304
For:	Heterogeneous Disk Storage Management Technique

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING OF THE DECISION ON APPEAL DATED MARCH 1, 2010

Sirs:

Appellants respectfully request reconsideration under 37 C.F.R. 41.52 of the Board of Patent Appeals and Interferences (the Board) Decision on Appeal dated March 1, 2010, because Appellants believe the Board misapprehended or overlooked certain points in rendering their decision. Since the two-month period for response falls on May 1, 2010, Saturday, this submission on May 3, 2010 is timely.

I. BACKGROUND

In the Decision of March 1, 2010, the Board issued a new ground of rejection of claims 1-3, 5-9 and 11 under 35 U.S.C. 112, second paragraph.

The Board alleged that the Appellants have not provided adequate guidance as to what the Appellants intend the claim language to cover with respect to limitations recited in the independent claims 1 and 7.

At issue in, for example, claim 1 is the following emphasized limitation:

> 1. A method for managing at least one storage device, comprising the steps of:
>
> (a) identifying the at least one storage device;
>
> (b) establishing a database containing information about the identified at least one storage device, wherein the information about the identified at least one storage device includes operating characteristics of the identified at least one storage device;
>
> (c) providing to the user a graphical user interface in accordance with the information in the database, the graphical interface displaying at least one menu option for the identified at least one storage device for the user to select at least one of (i) display of the information about the identified at least one storage device and (ii) execution of at least one process to control the operation of the at least one storage device;
>
> (d) processing the user-selected menu option, said processing further including:
>
> determining if the requested execution of the at least one process complies with *the operational rules* for the identified at least one storage device, and if not, blocking execution of the at least one process, and generating an error message; and
>
> (e) automatically updating the graphical user interface in response to the processing of the user-selected menu option.

The Board contends that two or more plausible claim constructions are possible for the claimed *operational rules* of step (d), and a similar feature in element (c) of independent claim 7. Appellants respectfully disagree.

II. The Board misapprehended or overlooked the following points

In Section V "ANALYSIS" of the Decision, the Board expressed uncertainty as to whether the Appellants intend to claim "the operational rule" or "the configuration rule" in step (d) of claim 1 and in element (c) of claim 7. The Board further found that, on page 3 of the Appeal Brief, the Appellants map "the operational rules" as the configuration rules.

Appellants respectfully submit that claims 1 and 7 refer to the "operational rules," and that they are not mapped as the configuration rules. As explained below, the "rules" referred to in the specification, e.g., p.3, line 26 – p.4, line 6, are not limited only to configuration rules.

In Section V, "Summary of Claimed Subject Matter" of the Appeal Brief, the Appellants cited p.3, lines 17-18 and p.4, lines 27-32 of the specification as examples of supporting text relating to the "operating characteristics" in step (b); and p.3, line 26 to p.4, line 6 as example of supporting text for step (d) of Claim 1.

The specification describes at least one database associated with a host system, with the database containing one or more libraries, and each library containing information specific to a corresponding storage device (e.g., p.3, lines 13-15). The library typically also includes operating characteristics associated with that storage device, with the operating characteristics including at least one of (a) operational rules, (b) commands, and (c) processing routines (e.g.,

p.3, lines 16-18). In addition, configuration rules are determined from the information stored in the corresponding library for each device (e.g., p.3, lines 29-30).

Thus, it is clear from the specification that a device library can include operational rules associated with the storage device, and that configuration rules for a storage device are determined from the information stored in the device library.

The specification also teaches that a COM/DCOM layer 20 in the host system includes programs that monitor each requested operation for each storage device to ensure that the requested operation complies with the "rules" for that storage device (e.g., p.3, line 26 to p. 4, line 3), and that: "Any requested operation of a storage device not in compliance with the rule(s) associated with that device will be blocked and an error message will be generated" (p.4, lines 3-5).

However, the specification does not limit such "rules" to only the configuration rules. For example, in connection with the COM/DCOM layer 20, FIG. 1 shows that "only the operations that adhere to the database of vendor specific rules are allowed to proceed," and FIG. 2 (method steps executed by the host system) shows a database containing configuration and operational rules (step 110).

Thus, one of ordinary skill in the art would understand that the rule(s) against which compliance is monitored for a requested operation can include configuration and/or operational rules, as taught in the specification. In other words, the specification provides support for the rules to include operational rules, and not just configuration rules.

As recited in claims 1 and 7, compliance is determined with respect to the operational rules.

Additionally, one skilled in the art would understand that in certain embodiments, operational rules and configuration rules may be related and intertwined, and that an operation may be enabled or disabled based on a configuration of the device. However, there is no requirement that the operational rules be mapped as configuration rules.

Thus, Appellants disagree that "the operational rules" are mapped as the configuration rules in Claims 1 and 7, because as discussed above, p.3, line 26 to p. 4, line 6 of the specification refers to the *rules*, which are not limited to being the configuration rules.

The Board also states that the two rules (i.e., configuration vs. operational) appear to be different set of rules because they are stored in different places and have different functions. Appellants submit that, since Claims 1 and 7 refer to the operational rules for the identified at least one storage device, the scope of these claims is definite, and not related to the functions or storage location of the configuration rules.

Therefore, Appellants respectfully submit that the Board has misinterpreted the specification as it relates to Claims 1 and 7, since the specification provides support for compliance with the rules, which include operational rules as recited in Claims 1 and 7.

Thus, the scope of claims 1-3, 5-9 and 11 is clear and Appellants respectfully request withdrawal of the new ground for rejection under 35 U.S.C. 112, second paragraph.

CONCLUSION

In light of the above, Appellants respectfully submit that the new ground of rejection of claims 1-3, 5-9 and 11 has been overcome, and further request reconsideration of the Appeal Brief as presented.

Respectfully submitted,
David Aaron Crowther et al.

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/Wan Yee Cheung/
Wan Yee Cheung
Reg. No. 42,410
Attorney for Appellants

U.S. Patent Operations
Thomson Licensing Inc.
P.O. Box 5312
Princeton, New Jersey 08540